



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,094	10/03/2003	James Bennett	102USBB02	3545

23446 7590 01/24/2007
MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

EXAMINER

HOPKINS, CHRISTINE D

ART UNIT	PAPER NUMBER
----------	--------------

3735

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/679,094

Applicant(s)

BENNETT, JAMES

Examiner

Christine D. Hopkins

Art Unit

3735

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-15 and 17-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-5, 7-15 and 17-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is responsive to the Amendment filed October 30, 2006. Claims 1-5, 7-15 and 17-20 are now pending. The Examiner acknowledges the amendments to claims 1, 7, 11, 13, 17, 18 and 20, as well as the cancellation of claims 6 and 16.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5, 7-15 and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Sedaros (U.S. Patent No. 6,004,259). Sedaros discloses an invention comprising an audio device that may be activated manually or by voice to generate the sound of a mother. With respect to claims 1 and 2, Sedaros teaches a doll, or “toy” (col. 1, lines 34-37), that may receive a “triggering event” such as the crying of a baby and subsequently generates a sound and plays sounds of the mother to induce a calming effect on the child (col. 1, lines 56-61).

With reference to claim 3, Sedaros teaches subsequent normal operation mode if the crying persists after the predetermined six minute interval. Hence, the child will be exposed to an additional six minutes of playback as determined by the invention when

Art Unit: 3735

he continues to cry. In view of claims 4-5, the "triggering event" can be manual, as in continuous playback (col. 1, lines 60-61) by activation of a switch (col. 2, lines 45-49), or automatic as activated by a signal from the child's crying to a microphone (col. 2, lines 23-26).

With respect to claims 7 and 9-10, the operating mode of Sedaros is that of a heartbeat and miscellaneous sounds captured when the mother pre-records into a microphone located on the device (col. 3, lines 25-30) into memory (col. 1, lines 8-13). In view of claim 8, the volume and pitch may be controlled via the volume control (col. 3, lines 6-10).

With reference to claims 11 and 12, the device of Sedaros contains a processing circuit that receives the "triggering event" from the child's voice and controls playback of a sound pre-recorded by the mother (col. 2, lines 21-23) and further comprises an audio output to generate the sound (col. 3, lines 6-10).

In view of claim 13, if the baby's crying persists, the device of Sedaros will be reactivated by the pulses received from the crying and continue in normal operation mode. Furthermore, the device may operate in a continuous On mode (col. 2, lines 45-46) or in a standby mode (col. 4, lines 8-11).

In reference to claims 14-15, the "triggering event" as taught by Sedaros can be manual, as in continuous playback (col. 1, lines 60-61) by activation of a switch (col. 2, lines 45-49), or automatic as activated by a signal from the child's crying to a microphone (col. 2, lines 23-26). Furthermore, in view of claim 17, the operating mode

of Sedaros is that of a heartbeat and miscellaneous sounds captured when the mother pre-records into a microphone located on the device (col. 3, lines 25-30).

With respect to claim 18, the device of Sedaros also contains a timer (col. 2, lines 33-34) and a volume control (col. 3, lines 6-10). Furthermore, in view of claim 19, it contains a memory (col. 1, lines 8-13) for storing the sound generated by the microphone and at any subsequent point for playback (col. 2, lines 66-67 and col. 3, lines 1-10).

With reference to claim 20, the device of Sedaros comprises a switch coupled to the processing circuit for mode operation (col. 2, lines 45-49); a timer (col. 2, lines 33-34) and a volume control (col. 3, lines 6-10); an audio output and speaker for generating the mother's pre-recorded sounds (col. 3, lines 1-10) and a microphone for recording the sounds (col. 3, lines 25-30) stored in memory (col. 1, lines 8-13).

Response to Arguments

4. Applicant's arguments filed October 30, 2006 with respect to the rejection of claims 1-20 under 35 U.S.C. 102(b) citing Sedaros ('259) have been fully considered but they are not persuasive. Regarding claim 1, Applicant contends that Sedaros fails to disclose "determining from within said audio enabled toy, a playback operating mode based on said received triggering event." However, this argument is not persuasive. A "playback operating mode" can be interpreted as any mode enabling functioning of the device such as powering on or off the device, and further does not require any limitation such as the modes claimed in claim 7 (decreasing, increasing or constant heartbeat

Art Unit: 3735

mode). Applicant further contends that Sedaros fails to disclose "selecting by audio enabled toy, at least one sound that mimics a mother's sounds." This argument is not persuasive because claim 1 at line 8 only requires "an audio signal representing at least *one* sound," that being interpreted as the sounds of a mother to induce calming effects (col. 1, lines 56-61) as disclosed by Sedaros. Moreover, Applicant contends that Sedaros fails to teach a playback operating mode from one of a plurality of playback operating modes, however this argument is not found persuasive since the claim language of claim 1 does not provide for a *plurality* of playback modes, but "a playback operating mode" (refer to lines 4 and 7 of claim 1 of the instant application).

Regarding claim 11, Applicant further contends that Sedaros fails to disclose "said processing circuit determines a playback operating mode based on said received triggering event" as well as "said processing circuit...selects from within said audio enabled toy." However, this argument is not persuasive considering the response above regarding "a playback operating mode" and that a processing circuit, or trigger circuit, as taught by Sedaros (see Fig. 1D) functions to "select" a sound mimicking a mother's sounds.

Additionally, regarding claim 20, Applicant contends that Sedaros fails to disclose "a mode control unit coupled to said processing circuit for determining a playback operating mode," and that the "playback operating mode" of Applicant is different than that of Sedaros. However, this argument is not persuasive regarding "a playback operating mode" as regarded in the response above and that the limitations suggested by Applicant in the specification are not found within the language of claim 20.

Art Unit: 3735

Furthermore, the device of Sedaros discloses a "mode control unit," or switch, coupled to the processing circuit for mode operation (col. 2, lines 45-49). In view of the foregoing, the rejection of claims 1-20 under 35 U.S.C. 102(b) as being anticipated by Sedaros ('259) is maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine D. Hopkins whose telephone number is (571) 272-9058. The examiner can normally be reached on Monday-Friday, 7 a.m.-3:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II can be reached on (571) 272-4730. The fax phone

Art Unit: 3735

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

cms

Christine D Hopkins
Examiner
Art Unit 3735



Charles A. Marmor, II
Supervisory Patent Examiner
Art Unit 3735